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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/136,820	08/19/1998	ISTVAN SIMON	98-370	2191

7590 03/19/2004

BACHMAN & LAPOINTE
SUITE 1201
900 CHAPEL STREET
NEW HAVEN, CT 065102802

EXAMINER

PONOMARENKO, NICHOLAS

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/136,820	Applicant(s) SIMON, ISTVAN	
	Examiner Nicholas Ponomarenko	Art Unit 2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant requested (through examiner's SPE) the reconsideration of the finality of the rejection of the last Office action. Per SPE's advice, the finality of that action is withdrawn.
2. In view of the Remand mailed on April 18, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

Specification

3. The amendment filed on July 19, 2001 is objected to under 35 U.S.C. 132 because it introduces **new matter** into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: the phrase **"(with water from a flowing water source such as, for example, a waterfall)"** (page 2, lines 11-12).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter,

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to disclose a device that is functional. Claim 1 sets forth the structure where **“energy input means”** provide energy to a **“drive output means”**. Applicant specification has support for the “drive output means” but has no support for the “energy input means”, as required under sixth paragraph of 35 U.S.C. 112, and as a results the claimed invention is inoperative. The drive output means is not considered to be a means plus function limitation. The energy input means is considered to be means plus function limitation.

Applicant, in his amendment, filed on July 19, 2001, added new matter. The added new matter – **“water from a flowing water source such as, for example, a waterfall”** – changed the function of the claimed “energy input means”. Before the addition of the new matter to the disclosure the applicant’s device had a structure with a function, which was described in the specification as **“movement of the cascade assemblies is afforded by overfilling of a cascade assembly in relation to the other ”**. This original structure used water for “overfilling of a cascade assembly” as a principal source of energy. This water for “overfilling” was coming from the “energy input means”, which is an internal structural element of the claimed device. The “energy input means” water was coming from the “cascade assembly” (“cascade assembly” is a feature of the “drive means”). This functionality is an example of an enclosed system, where the same water is utilized by the system to drive itself, i.e. –

the energy input means receives water from the drive means to provide water, as energy source, back to the drive means, perpetually. There was no external input or source of energy. By his amendment, applicant changed an enclosed system to an open system, by "hinting" about the existence of "flowing water ... from a waterfall" as a source of energy. This change introduced a new functionality to the "energy input means" in the claim, but without providing any structural support for this functionality in the disclosure. In another words, the claimed limitation "an energy input means" received a new functionality with the introduction of the new matter, but is not supported by the original disclosure and is not supported by the complete disclosure in the amended specification. Because the claimed function of "providing energy to the drive means" has no support in the disclosure, and presents an issue of a **new matter**, as shown in paragraph 3 of this Office action, the applicant has no possession of the claimed invention.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims **1-19** are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The device is inoperative because it has no source or input of energy for its operation.

When a patent applicant presents an application describing an invention that contradicts known scientific principles, or relies on previously undiscovered scientific

Art Unit: 2834

phenomenon, the burden is on the examiner simply to point out this fact to the appellant... The burden shifts to appellant to demonstrate either that his invention, as claimed, is operable or does not violate basic scientific principles, or that those basic scientific principles are incorrect. *As stated by the Patent Office Board of Appeals, Newman v. Quigg 681 F.Supp 16, at18, 5 U.S.P.Q. 2d 1880(1988).*

Applicants are required to furnish a working model of their invention in order to demonstrate its operability. See MPEP § 608.03.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant(s) disclosure. The most relevant is article from "Scientific American", Jan. 1968.

9. When the claims are amended, applicant(s) should state in detail where in the original disclosure or in the drawings the amended features find support. **No new matter may be introduced.**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Nicholas Ponomarenko** whose telephone number is **(703) 308-1776**.

11. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, Mon. - Fri., 8 AM - 5:30 PM
Phone: (703) 308-0956
Fax: (703) 305-3431

np
January 13, 2004



Nicholas Ponomarenko
Primary Examiner
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